



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,017	11/22/2000	Winnie C. Durbin	GEMS8081.023	5745
27061	7590	10/26/2006	EXAMINER	
ZIOLKOWSKI PATENT SOLUTIONS GROUP, SC (GEMS)			HEWITT II, CALVIN L	
14135 NORTH CEDARBURG ROAD			ART UNIT	
MEQUON, WI 53097			PAPER NUMBER	
			3621	

DATE MAILED: 10/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/681,017

Applicant(s)

DURBIN ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9-26-06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Status of Claims

1. Prosecution on the merits of this application is reopened on claims 1-26 and considered unpatentable for the reasons indicated below: New art has been found.

Claim Rejections - 35 USC § 101

2. Claims 18-26 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 18 is non-statutory as it recites non-functional data. Specifically, the claim is non-statutory because it is directed to a computer program not stored on a computer readable medium. Similarly, claim 23 is non-statutory because a carrier wave is not a computer readable medium as it is not persistent storage.

Claims 19-22 and 24-26 are also rejected as they depend from claims 18 and 23 respectively.

Claim Rejections - 35 USC § 103

3. Claims 1-7, 10-18, and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neville et al., U.S. Patent No. 6,272,636 in view of Leovac, U.S. Patent No. 6,668,375.

As per claims 1-3, 23, and 24, Neville et al. teach a sending a request/user ID to a server/clearinghouse (i.e. facility) ('636, column 13, lines 17-20) ("receiving a user ID at a facility from a user"). The request/user ID acts as a request, from a client to the server/clearinghouse, for a key to unlock locked software ('636, column 13, lines 25-27) (receiving a software request from the user specifying software to be enabled in equipment at a subscribing station). Neville et al. also teach "at a centralized facility, confirming that the software has not already been enabled because the server/clearinghouse determines whether or not the user is eligible to receive the unlock key ('636, column 13, lines 30-35). And if, the user is eligible to receive the unlock key, the user receives the key from the user and unlocks the software. Regarding the "confirming" step, the server/clearinghouse initially receives a request from a user ('636, column 13, lines 57-59). This is the first indication that the user is not using the software, otherwise, the user would not have a reason, in light of the teachings of Neville et al., to request an unlock key. The "confirmation" comes from the server/clearinghouse checking a use history database to confirm whether this is so ('636, column 13, lines 30-35; column/line 13/60-14/3). Neville et al. also teach^{es} a software key to enable software previously installed equipment (column/line 13/13-14/15). In the Board's Decision (2006-0490), the Board defined an option as "an item that is offered in addition to or in place of standard equipment" Webster's New Collegiate Dictionary (G. & C. Merriam Co. 1977).

aj

Therefore, to one of ordinary skill "standard equipment" is the user computer (column 10, lines 61-65; column 13, lines 54-55) or the user computer with a disabled or limited version of the software (column 2, lines 12-27). While in both cases, the fully functional version of the software (column/line 16/46-17/5) is the "item that is offered in addition" to the standard equipment. Nonetheless, Leovac teaches a method where a user can enable previously disabled options (where "option" is defined as "an item that is offered in addition to or in place of standard equipment", Webster's New Collegiate Dictionary (G. & C. Merriam Co. 1977)) in software by requesting a key from a remote center, wherein the key is generated at the center, specific to a user's system, and transmitted to the user over the internet (figure 2, items 13 and 17; column 3, lines 15-52; column 4, lines 5-22). Leovac also teaches determining options already in place on a user's system (column 3, lines 25-34) Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Neville et al. and Leovac in order ensure that payment is received for options enabled after installation ('375, column 1, lines 13-37).

As per claims 4, 5, 15, and 25, Neville et al. generally teach a system for executing software on a remote processor (abstract; column/line 10/62-11/5; column 12, lines 48-52). Neville doesn't explicitly recite a client system as a medical imaging scanner. However, an "end-user computer" (column 10, lines 62-67) is elastic enough to encompass any device that "accepts structured input,

processes it according to prescribed rules, and produces the results as output.” Regarding claims 5 and 25, Neville et al. specifically recite “try before you buy”, and “crippled” software distribution models (column 2, lines 11-47), therefore, it would have been obvious to one of ordinary skill to use the secure product execution method of Neville et al. to activate trial options or features (column/line 13/13-14/15).

As per claims 6, 7 and 26, both Neville et al. ('636, column/line 13/13-14/15) and Leovac ('375, column 3, lines 35-38) teach authenticating a user ID and downloading the enabling feature automatically, while Neville et al. teach downloading without further user input (column/line 13/13-14/15).

As per claims 10-14 and 16-18, Neville et al. teach validating an options request, creating an option key in response thereto, a communications network for relaying data, and transmitting the option key through an external communications network (figures 8 and 9; column 10, lines 62-65; column/line 13/13-14/15). Neville et al. generally teach a system for executing software on a remote processor (abstract; column/line 10/62-11/5; column 12, lines 48-52). Neville doesn't explicitly recite a client system as a medical imaging scanner. However, an “end-user computer” (column 10, lines 62-67) is elastic enough to encompass any device that “accepts structured input, processes it according to prescribed rules, and produces the results as output.” Neville et al. also teach receiving and validating a user ID/system ID, receiving an option request from a

user and invalidating a user ID/system ID (column 13, lines 20-35), comparing the request against other requests (column 13, lines 20-25 and 60-67) and “try before you buy” and “crippled” software distribution models (column 2, lines 11-47). Regarding “trial software”, Neville et al. recite evaluation periods based on a number of executions or time periods (column 13, lines 60-67) and tracking the number of user requests for a digital product (column 13, lines 20-25). However, Neville et al. do not specifically recite generating an option key in response to a user request. Leovac teaches a method and system for securely distributing software comprising the generation of an option key in response to a user request (figure 2, items 13 and 17). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Neville et al. and Leovac in order to prevent the uncontrolled distribution of software ('375, column 3, lines 34-64).

4. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neville et al., U.S. Patent No. 6,272,636 and Leovac, U.S. Patent No. 6,668,375, as applied to claim 1 above, and in further view of, Linden et al., U.S. Patent No. 6,360,254.

As per claims 8 and 9, Neville et al. teach a system for enabling software in a computer (abstract). Leovac teaches a method where a user can enable previously disabled options in software by requesting a key from a remote center, wherein the key is generated at the center specific to a user's system and

transmitted to the user over the internet (figure 2, items 13 and 17; column 3, lines 15-52; column 4, lines 5-22). However, neither Neville et al. nor Leovac specifically recite sending enabling features by e-mail and electronic confirmation of the option enablement. Linden et al. teach a secure method for enabling a remote computer to access a resource comprising sending an enabling feature by e-mail and sending a verification e-mail to the user confirming option enablement (column 11, lines 28-39). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Neville et al., Leovac and Linden et al. in order to distribute the key efficiently ('636, column 10, lines 62-65; '375, figure 2, items 13 and 17) and in a manner that is familiar to the user such as via e-mail ('254, column 11, lines 28-39).

5. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neville et al., U.S. Patent No. 6,272,636 and Leovac, U.S. Patent No. 6,668,375 as applied to claim 18 and in further view of Ernest, U.S. Patent No. 4,888,798.

As per claim 19, Neville et al. teach a client transmitting to a server (that is connected to a plurality of clients) a user ID/system ID for authentication with an option enabling request, comparing the request against other requests and the server distributing software keys over a communications network to the client for enabling software options in response to the client's transmission (abstract; column/line 13/13-14/15). Neville et al. also disclose "try before you buy" and

“crippled” software distribution models (column 2, lines 11-47). Leovac teaches a method and system for securely distributing software comprising the generation of an option key in response to a user request (figure 2, items 13 and 17).

However, neither Neville et al. nor Leovac specifically recite a software key with a disablement feature. Earnest teaches a system for securing distributed software using software keys, with a predetermined time based disablement option, to unlock specific features (column/line 14/66-15/30). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Neville et al., Leovac and Ernest in order more securely control trial period software ('676 abstract).

6. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neville et al., U.S. Patent No. 6,272,636 and Leovac, U.S. Patent No. 6,668,375 as applied to claim 18 above, and in further view of Oki et al., U.S. Patent No. 6,115,471.

As per claims 20-22, Neville et al. teach a client transmitting to a server (that is connected to a plurality of clients) a user ID/system ID for authentication with an option enabling request, comparing the request against other requests and the server distributing software keys over a communications network to the client for enabling software options in response to the client's transmission (abstract; column/line 13/13-14/15). Leovac teaches a method and system for securely distributing software comprising the generation of an option key in

response to a user request (figure 2, items 13 and 17). However, neither Neville et al. nor Leovac specifically recite authenticating a user ID prior to receiving a request and system ID. Oki et al. teach a software distribution system comprising authenticating a user ID, prior to receiving an option enabling request and receiving then authenticating a system ID (column/line 7/55-8/11). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Neville et al., Leovac and Oki et al. in order to prevent illegal copying of software ('471, column 8, lines 1-5).

Conclusion

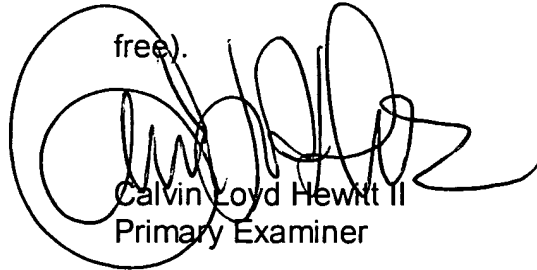
7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through

Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).



Calvin Loyd Hewitt II
Primary Examiner

September 18, 2006



WYNN W. COGGINS
TECHNOLOGY CENTER DIRECTOR